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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201703
Party	Plaintiff Michael Brandt Family Trust d/b/a Eco-Safe Industries, Inc.
Correspondence Address	BARTH X DEROSA DICKINSON WRIGHT PLLC 1875 EYE STREET NW , SUITE 1200 WASHINGTON, DC 20006 UNITED STATES BdeRosa@dickinson-wright.com, cholder@dickinsonwright.com, trademark@dickinsonwright.com, malcantara@dickinsonwright.com
Submission	Other Motions/Papers
Filer's Name	Barth X. deRosa
Filer's e-mail	bderosa@dickinsonwright.com, nwhitner@dickinsonwright.com, trademark@dickinsonwright.com
Signature	/Barth X. deRosa/
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Docket No. 229-182

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MICHAEL BRANDT FAMILY TRUST d/b/a ECO-SAFE OF DALLAS, Opposer, v. ISTITUTO ITALIANO SICUREZZA DEI GIOCATTOLI S.R.L., Applicant.	Opposition No. 91201703 Application Ser. No. 77/960,950

OPPOSER'S MOTION FOR JUDGMENT ON THE PLEADINGS

Opposer, Michael Brandt Family Trust, through its attorneys, respectfully moves for judgment on the pleadings in accordance with Rule 12(c) of the Federal Rules of Civil Procedure and Section 504 of the Trademark Manual of Board Practice. The pleadings are closed and this motion is made prior to the opening of the testimony period.

By its answer filed and served on July 1, 2013 to the Second Amended Notice of Opposition, Applicant has made specific admissions that its application should be declared void. Collectively, these specific admissions are made in Paragraphs 16, 17, 18, 21 and 22 of Applicant's answer and effectively constitute abandonment of its pending application.

Simply put, Applicant admits it had no *bona fide* intention to use the mark in commerce either at the time it filed its application or since that time for each of the goods listed in classes 22, 23, 24, 25 and 27. It also admits that it did not have a *bona fide* intent to use the mark for its services in class 42 at the time it filed its application, and since that time. [See paragraphs 21

and 22 of Applicant's answer]. Applicant also admits that it essentially attempted to "skirt pass" the anti-use by owner rule for certification marks in 15 U.S.C. §1054 by declaring its intent to use the mark for such goods and services when in reality it intended to use the mark as a certification mark. [See paragraphs 16, 17 and 18 of the Second Amended Notice of Opposition and Applicant's Answer thereto]. However, notwithstanding Applicant's clear actions and admissions, Applicant denies any allegation of fraud. [See paragraphs 24 – 29 of the Second Amended Notice of Opposition and Applicant's Answer thereto].

MEMORANDUM

Background

Opposer, Michael Brandt Family Trust, is the owner of a number of incontestable federal registrations for the mark ECO-SAFE used primarily for pest control related services and products. [See Paragraph 4 – Second Amended Notice of Opposition]. The mark ECO-SAFE has been used consistently and continuously by Michael Brandt Family Trust and its predecessor since 1972.

Applicant, a certifying entity located in Italy, on March 17, 2010 filed under Section 44(e) an application to register the mark "ECO-SAFE and Design" declaring its *bona fide* intent to use the mark for a variety of products falling within classes 22, 23, 24, 25, and 27 and also a *bona fide* intent to use the mark in connection with services namely "testing, analysis and evaluation of textile products of others and toys of others for purposes of certification." As evidenced by the various web pages derived from Applicant's website and attached to Opposer's Second Amended Notice of Opposition, Applicant made these declarations of intent to use notwithstanding the fact that Applicant has always served as a certifying entity, has never manufactured such products or offered such services and, as now admitted, never had a *bona fide* intent to do so.

With time extended, Opposer timely filed its Notice of Opposition alleging a likelihood of confusion, a likelihood of reverse confusion, fraud, violation of the anti-use by owner rule, and lack of *bona fide* intent. Following service of the Notice of Opposition, Applicant embarked on a campaign to obfuscate the issues by filing three separate motions to dismiss. By Order dated May 31, 2013 the Board agreed with Opposer that its allegations of fraud were sufficiently pleaded with particularity and where applicable, on information and belief, in view of the decision by the Circuit Court of Appeals for the Federal Circuit in *In Re Bose Corp.*, 580 F.3d 1240 (Fed Cir 2009).

The Law and Facts

A. Applicant Admits it Lacked a *Bona Fide* Intent

As noted in TMBP §504.02, a motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all pleadings, supplemented by any facts of which the Board will take judicial notice.

A judgment on the pleadings may be granted only where, on the facts deemed admitted, there is no genuine issue of material fact to be resolved and the moving party is entitled to judgment on the substantive merits of the controversy as a matter of law.

As set forth in Sections 1(b) and 44(e) of the Act, every person who files an application in the United States must have a *bona fide* intention to use the mark in commerce in connection with each of the products and services as stated in the application. Without such a *bona fide* intent to use the mark, the application is declared void and the opposition is sustained. See generally *Commodore Electronics Apple TD vs. CBM Kabushiki Kaisha* 26 U.S.P.Q. 2d 1503, 1508 (TTAB 1993).

It is undisputed by Applicant's admissions that it "had no such bona fide intent at the time it filed the application, and continues to have no such bona fide intent" to use the mark as a trademark for the various goods and services stated within its application.

As stated in Paragraphs 21 and 22 of the Second Amended Notice of Opposition and the Applicant's answers thereto:

> Paragraph 21
>
> Insofar as Applicant has declared that it has a *bona fide* intent to use the mark as a trademark for the goods identified in Classes 22, 23, 24, 25 and 27, and as a service mark for the services in Class 42, upon information and belief, Applicant had no such *bona fide* intention at the time it filed the application, and continues to have no such intention to use the mark as a trademark for the goods identified in Classes 22, 23, 24, 25 and 27 and services in Class 42.
>
> Paragraph 21 Answer:
>
> Applicant **admits** [emphasis added] that its application should be declared void because it was erroneously not characterized as a certification mark in its application and denies the remainder of this paragraph.
>
> Paragraph 22
>
> Because Applicant lacks a *bona fide* intent to use the mark as a trademark and service mark, and never had such *bona fide* intent, the application should be declared void.
>
> Paragraph 22 Answer:
>
> Applicant **admits** [emphasis added] that its application should be declared void because it was erroneously not characterized as a certification mark in its application and denies the remainder of this paragraph.

B. Applicant Admits that it Intended to Circumvent the Anti-Use by Owner Rule for Certification Marks.

Paragraphs 16, 17 and 18 of Opposer's Second Amended Notice of Opposition concerns Applicant's *bona fide* intent to use the "ECO-SAFE and Design" mark as a trade and service mark in violation of the anti-use by owner rule. Again, Applicant admits that it intended to violate this statutory bar:

Paragraph 16

Applicant's website at http://www.ecosafetextile.com/en/ shows that Applicant is using the applied-for mark as a certification mark, and not as a trademark for the products in Classes 22, 23, 24, 25 and 27, and not as a service mark to designate the source of services in Class 42 related to "[t]esting, analysis and evaluation of…textile products of others and toys of others[.]"

Paragraph 16 Answer:

Admit; [Emphasis Added] however to the extent that this allegation alleges that certain content appears on Applicant's website, Applicant notes that its website speaks for itself and denies such portions on this basis.

Paragraph 17

Insofar as Applicant has declared that it has a *bona fide* intention to use the "ECO-SAFE & Leaf Design" mark as a trademark in connection with the goods in Classes 22, 23, 24, 25 and 27 in commerce in connection with the sale or offering of such products, but in reality intends to use and is in fact using the applied for mark as a certification mark, said bona fide intention is, as a matter of law, inconsistent with the anti-use by owner rule for certification marks under 15 U.S.C. §1054, and Applicant's Serial No. 77/960,950 is therefore *void ab initio*.

Paragraph 17 Answer:

Admit. [Emphasis Added]

Paragraph 18

Insofar as Applicant has declared that it has a *bona fide* intent to use the mark as a service mark in connection with the testing, analysis and evaluation of the goods and services of others for the purposes of certification, but, in reality, intends to and is, in fact, using the applied-for mark as a certification mark, said *bona fide* intention, is as a matter of law, inconsistent with the anti-use by owner for certification marks under 15 U.S.C. Section 1054, and Applicant's Serial No. 77/960,950 is therefore *void ab initio*.

Applicant's answer to each of these Paragraphs:

Paragraph 18 Answer:

Admit. [Emphasis Added]

Insofar as Applicant has therefore admitted it has no *bona fide* intention to use the mark for the goods and services identified in classes 22, 23, 24, 25, 27 and 42 and that any such intent

would in fact be inconsistent with the anti-use by owner rule in 15 U.S.C. §1054, Applicant's application should be declared void and the opposition sustained.

C. The Undisputed Facts and Pleadings Support Fraud with an Intent to Deceive.

Furthermore, insofar as Applicant now admits that it (1) had no such intent to use the mark as a trademark and service mark as stated in its application and (2) that it has taken the position that it was not intending to use the mark as a certification mark in its earlier pleadings[1] when in reality it never intended to use it as a trade and service mark, it is respectfully submitted that it is within the Board's province to take judicial notice of the facts and find that Applicant, notwithstanding its denials, committed fraud on the United States Patent and Trademark Office.

In accordance with *In Re Bose Corp.*, supra, the now admitted facts support an undisputed finding of fraud:

1. The Applicant made a false representation to the USPTO where it falsely declared its *bona fide* intent to use the mark for goods and services, when it now admits it had no such intention.
2. A false *bona fide* intent to use the mark in connection with goods and services is absolutely material to registrability of the mark;
3. Applicant had knowledge of the false representation insofar as it has never manufactured the products, never offered the designated services, and has always existed as a "certifying" entity.

[1] See e.g., Applicant's Answer and Response to first Amended Notice of Opposition – Affirmative Defenses filed February 24, 2012 where Applicant blatantly misrepresented facts now admitted: "Sicurezza's application cannot be void or void ab inito as a matter of law because Sicurezza's had a *bona fide* intent to use its mark with at least some of the goods and services listed in its application."

4. The facts and pleadings evidence an intent to deceive. For example, compare Applicant's intentionally false declaration of *bona fide* intent, to its own pronouncements as set forth in Paragraphs 10-18 and Exhibit A in the Second Amended Notice of Opposition and its earlier pleadings.

The facts and pleadings belie any possible notion that Applicant was operating under a mistaken interpretation or understanding of the law. Compare and reconcile e.g. Melodrama Publishing LLC v. Santiago, Civil Action No. 12-Civ. 7830 (S.D.N.Y. April 11, 2013) with C. & J. Clark International Ltd. v. Unity Clothing, Inc., Cancellation No. 92049418 (April 24, 2013).

Conclusion

In view thereof, it is respectfully submitted that Applicant's admissions constitute abandonment of its application without the consent of Opposer and that the facts conclusively establish fraud on the United States Patent and Trademark Office. Accordingly, the opposition should be sustained.

Further action is respectfully solicited.

Respectfully submitted,

MICHAEL BRANDT FAMILY TRUST
d/b/a ECO-SAFE OF DALLAS

Dated: August 22, 2013

/s/ Barth X. deRosa

Barth X. deRosa
DICKINSON WRIGHT PLLC
1875 Eye Street, N.W.
Suite 1200
Washington, D.C. 20006
Phone (202) 457-0160
Fax (202) 659-1559
Counsel for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the Opposer's Motion for Judgment on the Pleadings has been served upon Applicant on this 22nd day of August 2013, via first class mail, postage prepaid, as identified below:

Jeffrey M. Goehring
Young & Thompson
209 Madison Street
Suite 500
Alexandria, VA 22314-1764

and

jgoehring@young-thompson.com

/s/ Barth X. deRosa
Barth X. DeRosa